

## Remarks

Claims 1-12 are pending in the application. The Applicant gratefully acknowledges the indication of allowable subject matter in claims 7-12 and 5-6. Claims 1 and 5 have been amended. The specification has been amended. New claims 13-21 have been added to the application. Reconsideration of the application is respectfully requested for the reasons set forth herein.

1. The Examiner has stated that the application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumed that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. The Examiner further stated that the Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

The subject matter of the various claims was commonly owned at the time any inventions covered therein were made.

2. The Examiner has rejected claims 1-4 under 35 U.S.C. 103(a) as being unpatentable over Maeda (US Patent No. 5,811,728).

In regard to claim 1, the Examiner stated that Maeda discloses a waterproof grommet 21 comprising a first member having a first sealing part 25 formed on an inner surface of at least one through-hole through which an electrical wire that connects the contact is passed and which

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can adhere tightly to the electrical wire. A second member having a second sealing part 37 which is formed on an outer circumferential surface of the through-hole and which can adhere tightly to a connector housing 29. The Examiner further stated that Maeda fails to disclose the first member having the first sealing part formed from an elastic material that has a lower hardness than the hardness of the second member having the second sealing part. The Examiner, however, concluded that it would have been an obvious matter of design choice to use the first member having the first sealing part formed from an elastic material that has a lower hardness than the hardness of the second member having the second sealing part since the Applicant has not disclosed that the first member is formed from an elastic material that has a lower hardness than the hardness of the second member to solve any stated problem or for any particular purpose, and it appears that the invention would perform equally well if designed with the first member and the second member of Maeda.

Claim 1 has been amended to state that the first and second member are formed from an elastic material, the elastic material of the first member having the first sealing part is formed from an elastic material that has a lower hardness than the elastic material of the second member having the second sealing part to prevent splitting on the inner surface of the through-hole when the electrical wire is passed therethrough. Maeda teaches a cylindrical waterproof rubber tap 21 having an insertion hole 23 for receiving an electric wire. A plurality of annular bulge portions 25 are formed on an inner wall of the insertion hole 23. A plurality of sealing annular projecting portions 27 are formed on an outer periphery of the waterproof rubber tap 21 to engage a connector housing 29. Maeda does not teach or suggest that the waterproof rubber tap 21 is formed from an elastic material where the elastic material adjacent to the insertion hole 23 is harder than the elastic material at the outer periphery of the waterproof rubber tap 21 to prevent

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splitting of the inner wall of the insertion hole 23. Maeda, therefore, does not teach or suggest the claim limitation that the elastic material of the first member having the first sealing part is harder than the elastic material of the second member having the second sealing part to prevent splitting on the inner surface of the through-hole when the electrical wire is passed therethrough. Because Maeda does not teach or suggest all of the claim limitations of amended claim 1, the Examiner has failed to set forth a prima facie case of obviousness. Removal of the rejection of claim 1 under 35 U.S.C. 103(a) is respectfully requested.

Claims 2-3 depend from independent claim 1. As previously discussed, Maeda does not teach or suggest all of the elements of amended claim 1. Specifically, Maeda does teach or suggest that the first and second member are formed from an elastic material, the elastic material of the first member having the first sealing part is formed from an elastic material that has a lower hardness than the elastic material of the second member having the second sealing part to prevent splitting on the inner surface of the through-hole when the electrical wire is passed therethrough. Because Maeda does not teach or suggest all of the claim limitations of claims 2-4, the Examiner has failed to set forth a prima facie case of obviousness. Removal of the rejection of claims 2-4 under 35 U.S.C. 103(a) is respectfully requested.

3. The Examiner has rejected claims 5-6 under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 5 has been amended such that the recessed parts are consistently recited to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Reconsideration and removal of the rejection of claim 5 under 35 U.S.C. 112, second paragraph, is respectfully requested.

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Claim 6 depends upon claim 5. Because claim 5 is now considered to be in condition for allowance, claim 6 is also considered to be in condition for allowance. Removal of the rejection of claim 6 under 35 U.S.C. 112, second paragraph, is respectfully requested.

4. New claims 13-21 have been added to the application.

New claims 13-18 depend from independent claim 1. Because claim 1 is considered to be in condition for allowance for the reasons set forth herein, claims 13-18 are also considered to be in condition for allowance.

New claim 19 is considered to be in condition for allowance, because the prior art fails to teach or suggest a waterproof grommet assembly comprising a first member having a first sealing part formed on an inner surface of a through-hole that sealingly engages an electrical wire received in the through-hole, a second member having a recessed part for receipt of a protrusion formed on a corresponding support member and a second sealing part formed on an outer circumferential surface of the through-hole that sealingly engages a housing. New claims 20-21 depend from independent claim 19. Because claim 19 is considered to be in condition for allowance for the reasons set forth herein, claims 20-21 are also considered to be in condition for allowance.

Examination of new claims 13-21 is respectfully requested.

In view of the amendments and arguments presented herein, the application is considered to be in condition for allowance. Reconsideration and passage to issue is respectfully requested.

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A check in the amount of \$102.00 to cover the cost of a fourth independent claim under 37 C.F.R 1.16(b) and one claim in excess of twenty under C.F.R 1.16(c) is attached. Please charge any additional fees associated with this application to Deposit Order Account No. 501581.

Respectfully submitted,

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**Version with Markings to Show Changes Made**

**In the Specification:**

Please replace the paragraph on page 4, line 32 to page 5, line 5 with the following:

The first member 20 is formed from an elastic material that is [harder] softer than the material used to form the second member 30. The first member 20 and the second member 30 are preferably formed from silicone rubbers that have different degrees of hardness. Here, a silicone rubber with a hardness of 10 is used for the first member 20. A silicone rubber with a hardness of 50 is used for the second member 30. The first 20 and second 30 members are formed as an integral unit by two-color molding.

**In the Claims:**

1. (Amended) A waterproof grommet comprising:

a first member having a first sealing part formed on the inner surface of at least one through-hole through which an electrical wire that connects a contact is passed, and which can adhere tightly to the electrical wire;

a second member having a second sealing part which is formed on the outer circumferential surface of the through-hole, and which can adhere tightly to a connector housing; and

the first and second member are formed from an elastic material, the elastic material of the first member having the first sealing part is formed from an elastic material that has a lower hardness than the [hardness] elastic material of the second member having the second sealing part to prevent splitting on the inner surface of the through-hole when the electrical wire is passed therethrough.

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5. (Amended) The waterproof grommet of Claim 1 wherein the second member has [at least one] recessed [part] parts [which is] used to align a contact cavity formed in the connector housing with the through-hole by engaging with [at least one] protruding [part] parts formed on a waterproof grommet supporting member; and

the recessed [part(s)] parts are formed so that the distances between the recessed [part(s)] parts and the outer circumferential surface are substantially the same, and so that the distances between the recessed [part(s)] parts and the [through-hole(s)] through-holes are substantially the same.

Add claims 13-21.

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